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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/995,158
Filing Date: November 27, 2001
Applicant(s): BANK, Lawrence C.
Title: STRUCTURAL REINFORCEMENT USING COMPOSITE STRIPS

Group Art Unit: 1774
Examiner: Thompson, Camie S.
Atty. Docket: 09820.176

REQUEST FOR RECONSIDERATION OF REQUIREMENT FOR RESTRICTION (37 CFR §1.143)

Box: Non-Fee Amendment
Assistant Commissioner for Patents
Washington, D.C. 20231

To the Commissioner: In Response to the Office Action of April 9, 2003, reconsideration of the restriction requirement is requested in light of the following comments.

1. Summary of Restriction Requirement and Provisional Election

The Examiner contends that the inventions claimed in the following groups are patentably distinct and require restriction to a single group:

Group I: The apparatus of claims 1-13 and 19-20, allegedly classified in class 428, subclass 114 (class definition: stock material or miscellaneous articles, structurally defined web or sheet, including grain, strips, or filamentary elements in different layers or components parallel).

Group II: The apparatus of claims 14-18, allegedly classified in class 29, subclass 897.35 (class definition: metal working, method of mechanical manufacture, structural member making, beam or girder).[1]

[1] It is questioned why this class is believed to be proper. Note that claim 14 is in no way restricted to "metal working," nor to "beams and girders."

I certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office as follows:

1774	(703) 872-9310	4-24-03	Marcia Layton
Group Art Unit	Facsimile No.	Date	Signature

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Group I (claims 1-13 and 19-20) is provisionally elected for further examination. However, it is submitted that both groups should be maintained for examination in light of the traversals set forth below.

2. Traverse: Bases for Restriction are Not Met

Two conditions must both be met before a proper requirement for restriction can be made (MPEP 803):

(1) The inventions must be independent or distinct as claimed; ***and***

(2) There must be a serious burden on the Examiner if restriction is not required.

As discussed below in sections 2.a and 2.b, it is submitted that neither condition is met for the above-noted groups.

2.a. First Criterion for Restriction: Serious Burden on the Examiner

As discussed by MPEP 803 and 808.02, a prima facie showing of a serious burden on the Examiner may be established by the Examiner's showing of a different field of search, separate classification, or separate status in the art. With respect to separate classification or separate status in the art, it is important to note that these do not automatically provide evidence of a serious burden; rather, they only do so where they demonstrate that a different field of search is indeed present (MPEP 808.02).

What constitutes a "different field of search" is defined in MPEP 808.02 and MPEP 904-904.03. MPEP 808.02 states that a different field of search exists "where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists." MPEP 904-904.03 then provide guidelines for the field of the search to be performed prior to examination of an application. It is noted that the art must be searched with respect to variant embodiments (MPEP 904.01(a)), patentable equivalents (MPEP 904.01(b)), and analogous art (MPEP 904.01(c)). MPEP 904.02 further notes that the Examiner's field of search should "cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed" (as does MPEP 904.02(a)), and MPEP 904.03 states that the search must be "commensurate with the limitations appearing in the most detailed claims in the case."

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It is evident from the principles set forth in the aforementioned sections of the MPEP that there is no different field of search for Groups I and II, and that no serious burden to the Examiner would arise if all claims are searched and examined. Kindly carefully review the elements/limitations recited in claims 1, 14, and 19; it is seen that there is substantial overlap. In accordance with MPEP 904-904.03, the field of search for both Groups should be the same since each Group is analogous art to the other in accordance with the principles of *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986) and *In re Wood*, 202 USPQ 171, 174 (CCPA 1979). Since there is no serious burden, it is submitted that the requirement for restriction should be withdrawn. As noted by MPEP 803, if the search and examination of an application can be made without serious burden, the Examiner must examine the application on the merits even though it includes claims to distinct or independent inventions.

2.b. Second Criterion for Restriction: Distinct or Independent Inventions

The Examiner contends that the inventions of Groups I and II are distinct under MPEP 806.05(f) as a process of making and a product made. This section provides:

> A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process as *claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process.

Here, the Examiner states that "a composite material wherein the fibers are metallic fibers can make a reinforced structure," which appears to be an argument that the method of Group II can be used to make a product materially different from the one of Group I. However, the stated rationale is either inapposite or misunderstood: *neither claim 1, nor claim 14, nor claim 19, are limited to metallic or nonmetallic fibers*, so it is simply not seen how/why metallic fibers are relevant. Also, observe the method of claim 14 versus the product of claim 19: the process as claimed cannot be used to make materially different products (and the product as claimed cannot be made by a materially different process). Since a showing of distinctness has not been made, the restriction requirement should be withdrawn.

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3. **Traverse: Claims 1, 14, and 19 are Linked**

As per MPEP 809.03, claims may be so linked as to make them inseparable. Note that claims 1 and 14 are linked (not distinct) as per MPEP 806.05(h), and claims 14 and 19 are also linked (not distinct) as per MPEP 806.05(f) – and claims 1 and 19, both being in Group I, are inherently linked. In other words, each independent claim links the other two. Again, kindly review and compare claims 1, 14, and 19 and the limitations recited therein, and the relationship is apparent.

4. **In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,

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RE:
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